

## **REMARKS**

Favorable reconsideration of this application is requested in view of the following remarks. Claims 1 and 18-20 are amended to clarify the invention and remain actively pending in the case. No new matter has been added. Reconsideration of the claims is respectfully requested.

In paragraph 5 on page 3 of the Office Action, claims 1 and 18-20 were objected to because they include the phrase “sheet of media located in said selected subject image file” and Examiner does not understand how a sheet of media is located in a computer image file. Applicants respectfully traverse the objection, but in the interest of furthering prosecution, Applicants have amended the independent claims to clarify the invention. Applicants respectfully submit that the claims are clear and in condition for allowance and requests that Examiner withdraw the objection.

In paragraph 6 on page 4 of the Office Action, claims 1, 2-4, 7-9 and 16-20 are rejected under 35 USC §103(a) as being unpatentable over Kinjo (6,519,046) in view of Miyazaki et al. (6,619,166). In paragraph 7 on page 10 of the Office Action, claims 14 and 15 are rejected under 35 USC §103(a) as being unpatentable over Kinjo and Miyazaki as applied to claim 1 above, and further in view of Fernandez et al. (2002/0092215). In paragraph 8 on page 11 of the Office Action, claim 12 is rejected under 35 USC §103(a) as being unpatentable over Kinjo and Miyazaki as applied to claims 1 and 9 above, and further in view of Buck (5,851,614). In paragraph 9 on page 11 of the Office Action, claim 11 is rejected under 35 USC §103(a) as being unpatentable over Kinjo and Miyazaki as applied to claims 1 and 9 above, and further in view of Peck (5,899,010). In paragraph 10 on page 12 of the Office Action, claim 10 is rejected under 35 USC §103(a) as being unpatentable over Kinjo and Miyazaki as applied to claims 1 and 9 above, and further in view of Ogikubo (5,994,990). In paragraph 11 on page 13 of the Office Action, claim 13 is rejected under 35 USC §103(a) as being unpatentable over Kinjo and Miyazaki as applied to claim 1 above, and further in view of Poole (5,962,368).

As admitted by the Office Action, Kinjo fails to teach cutting operations based on position location information. More specifically, Kinjo fails to teach or suggest at least conducting cutting operations, with respect to said

selected subject on said sheet of media, at predetermined locations on said sheet of media based on position location information stored in said selected subject image file as recited in claim 1.

In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "'usually . . . dispositive. . . [and] the single best guide to the meaning of a disputed term.'" Id. (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317.

Kinjo merely traces an outline of a part 120 of a displayed image and information about the traced part 120 is registered in memory 96 using registration data. More specifically, the registration data stored in memory 96 is used to locate the part 120 of the displayed image. See Col. 18, line 63 - Col. 19, lines 18.

Miyazaki fails to remedy the deficiencies of Kinjo as Miyazaki fails to teach or suggest at least conducting cutting operations, with respect to said selected subject on said sheet of media, at predetermined locations on said sheet of media based on position location information stored in said selected subject image file. Rather, Miyazaki merely discloses a printing apparatus in which a cutting pattern is selected from a plurality of predetermined cutting patterns. See Col. 2, lines 19-20. In Miyazaki, predetermined layout and image shapes are made available to the user. In operation, the first step is the selection of an image illustrated by 10A in Figure 16. Then a layout and punching shape is selected. See Fig. 16, 10B and 10C; Col. 10, lines 62-65. Template images such as those set forth in Figures 20A, 20B and 20C are used in conjunction with images to produce composite images as set forth in Figures 21A, 21B and 21C respectively. These images are printed in a pattern in accordance with a selected layout. See Col. 10, line 58 – Col. 12, line 23. An indicator "M" for phasing paper with a cutter roller is printed at the same time as an image. A photo-reflector 28 senses the indicator "M", which is the reference point for cutting the image. Accordingly, Miyazaki does not disclose, expressly or inherently, conducting

cutting operations at predetermined locations on said sheet of media based on position location information stored in said selected subject image file.

Applicants respectfully submit that the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Applicants respectfully request that the Examiner submit an affidavit as to the Examiner's personal knowledge or submit a prior art reference suggesting the desirability of modification.

Thus, in view of the above remarks, Applicants' invention is patentable over the cited references. It is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of Fernandez, Buck, Peck, Ogikubo, Poole as applied to the above prior art references is moot, inasmuch as the combination of Kinjo, Miyazaki, Fernandez, Buck, Peck, Ogikubo and Poole still lacks any teaching, disclosure, or suggestion concerning conducting cutting operations at predetermined locations on said sheet of media based on position location information of said selected subject on said sheet of media located in said selected subject image file as previously discussed.

In addition, Appellants respectfully contend that a *prima facie* case of obviousness has not been established, as described more fully below. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
  - 2) there must be a reasonable expectation of success; and
  - 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.
- (M.P.E.P. §2142).

Applicants respectfully submit that the cited references do not teach or suggest all the claim limitations as discussed above.

Further, there must be some actual *motivation* to combine the references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest

the combination. Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

For example, it is respectfully submitted that Kinjo fails to provide any suggestion to implement or otherwise be combined with image cutting apparatus as described in Miyazaki. Moreover, Miyazaki fails to provide any suggestion to implement or otherwise be combined with registration data as described in Kinjo.

Thus, Applicants respectfully contend that a *prima facie* case of obviousness has not been established as no “clear and particular” evidence of motivation to combine can be identified. The Examiner must show some objective teaching leading to the combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). It is respectfully submitted that there is no such objective teaching in at least Kinjo that leads “to the combination” of Kinjo with Miyazaki, and the Examiner has pieced together aspects purportedly found in the prior art to arrive at the invention through hindsight. As stated by the Federal Circuit:

“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply **takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.**”

*In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); emphasis added).

As such, there is no basis in the references themselves to motivate a person skilled in the art to combine at least the Kinjo reference with the Miyazaki reference.

Therefore, in view of the above remarks, Applicants’ independent claim 1 is patentable over the cited references. Rejected independent claims 18-20

recite one or more features generally similar to those of claim 1 discussed above. Accordingly, for similar reasons as discussed above, independent claims 18-20 are believed to be patentable over the cited references. Because claims 2-4 and 7-17 depend from claim 1 and include the features recited in the independent claim, Applicants respectfully submit that claims 2-4 and 7-17 are also patentably distinct over the cited references. Nevertheless, Applicants are not conceding the correctness of the final Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Deposit Account No. 05-0225.

Respectfully submitted,



\_\_\_\_\_  
Attorney for Applicant(s)  
Registration No. 53,950

Thomas J. Strouse/phw  
Rochester, NY 14650  
Telephone: 585-588-2728  
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.